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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/552,849

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Scott Phillips

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EXAMINER

LARYEA, LAWRENCE N

ART UNIT

PAPER NUMBER

3768

MAIL DATE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/552,849	<b>Applicant(s)</b> PHILLIPS ET AL.	
	<b>Examiner</b> LAWRENCE N. LARYEA	<b>Art Unit</b> 3768	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/11/2005</u> .  | 6) <input type="checkbox"/> Other: ____.                          |

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 1 is rejected under 35 U.S.C. **102(b)** as being anticipated by **Hyman et al (Patent 6,113,542)**

3. **Hyman et al** teach a device for determining corrected intraocular pressure comprising: a corneal pachymeter **(10)**; a microprocessor **(12)** which automatically receives corneal thickness data from said pachymeter; an input device for receiving a tonometer reading from a separate tonometer **(2)**; said microprocessor configured to execute at least one algorithm for modifying said tonometer reading based on the corneal thickness data to produce a corrected intraocular pressure value and a display for displaying the corrected intraocular pressure value. **(See Abstract, Col.1, lines 7-20, Col.2, lines 12-46, Col.3, lines 15-21 and Col.4, Table1)**

4. Claims 14-15 are rejected under 35 U.S.C. **102(b)** as being anticipated by **Sklar et al (US Patent 5,098,426)**.

5. Claims 14-15: **Sklar et al** teach a pachymeter comprising a display **(19)** and at least one stored **(memory storage)** set of a plurality of predetermined locations for taking a set of pachymeter measurements wherein the display is configured to display a graphical representation of an eye marked with indicia to graphically indicate one of the

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predetermined locations at which a next pachymeter measurement of the set ought to be taken **(See Figures 2,5A, 6 and 8 and Col.10, lines 32-52).**

6. Examiner acknowledges indicia displayed on screen to assist in performing medical procedures. The indicia (printed matter) displayed on the apparatus is construed to define the intended use of the apparatus. The display is the apparatus.

7. Therefore information (graphic) or indicia displayed on a screen does not carry any patentable weight, since *it is well established that a mere arrangement of printed matter, though seemingly a "manufacture," is rejected as not being within the statutory classes. See In re Miller, 418 F.2d 1392, 164 USPQ 46 (CCPA 1969); Ex parte Gwinn, 112 USPQ 439 (Bd. App. 1955); and In re Jones, 373 F.2d 1007, 153 USPQ 77 (CCPA 1967). In the present application, the claimed printed matter set forth a mere arrangement of printed matter that is not functionally related to the substrate and, therefore, does not distinguish the invention from prior art in terms of patentability. Although printed matter must be considered, in this situation, it is not entitled patentable weight. The printed matter claimed herein conveys no meaningful information in regard to the substrate they are arranged on and do not require any size relationship of the substrate, and do not require any particular substrate to effectively convey the information. Accordingly, there being no functional relationship of the printed material to the substrate, as noted above, there is no reason to give patentable weight to the content of the printed matter which, by itself, is non-statutory subject matter.*

Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. In *re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a

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specific type of indicia or display on a screen does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2-9,12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Hyman et al (Patent 6,113,542)** as applied in claim 1, in view of **Kremer et al (Patent 4,546,773)**.

10. **Hyman et al** teach a device for determining corrected intraocular pressure comprising: a corneal pachymeter **(10)**; a microprocessor **(12)** which automatically receives corneal thickness data from said pachymeter; an input device for receiving a tonometer reading from a separate tonometer **(2)**; said microprocessor configured to execute at least one algorithm for modifying said tonometer reading based on the corneal thickness data to produce a corrected intraocular pressure value and a display for displaying the corrected intraocular pressure value. **(See Abstract, Col.1, lines 7-20, Col.2, lines 12-46, Col.3, lines 15-21and Col.4, Table1)**

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**11. Hyman et al** teach the claimed invention see supra rejection **Hyman et al** teach does not teach that the pachymeter comprises a pulse generator; an ultrasonic transducer connected to generate an ultrasonic pulse in response to a pulse from the pulse generator; and, a circuit for detecting reflected ultrasonic signals reflected at a back side of the cornea, amplifying the detected reflected ultrasonic signals and measuring a time between the generation of the ultrasonic pulse and the detection of the reflected ultrasonic signals.

**12. Kremer et al** teach a pachymeter which comprises various suitable arrangements for corneal examination measurements and the arrangements includes a pulse generator; an ultrasonic transducer connected to generate an ultrasonic pulse in response to a pulse from the pulse generator; and, a circuit for detecting reflected ultrasonic signals reflected at a back side of the cornea, amplifying the detected reflected ultrasonic signals and measuring a time between the generation of the ultrasonic pulse and the detection of the reflected ultrasonic signals and a display for displaying the corrected intraocular pressure value in order to improve the safety and accuracy of performing surgery on the cornea with electrical means (**See Fig. 13, Col. 5, lines 60- Col. 6, lines 1- 67 and Figures 10-16**).

It would have been obvious to one having ordinary skill in the art at the time invention was made to modify a pachymeter of **Hyman et al** to include the suitable arrangements of an ultrasonic transducer connected to generate an ultrasonic pulse in response to a pulse from the pulse generator; and, a circuit for detecting reflected ultrasonic signals reflected at a back side of the cornea, amplifying the detected

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reflected ultrasonic signals and measuring a time between the generation of the ultrasonic pulse and the detection of the reflected ultrasonic signals and a display for displaying the corrected intraocular pressure value of **Kremer et al** to ensure accuracy of cornea thickness measurements since **Hyman et al** requires a pachymeter and **Kremer et al teach** such suitable arrangements for use therein (**See Col. 3, lines 25-36, Col. 1, lines 66- 68, Col. 1, lines 9- 23 and Col. 2, lines 34-41**) as taught by **Kremer et al**.

13. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Hyman et al (Patent 6,113,542)** as applied in claim 1, in view of **view of Sklar et al (US Patent 5,098,426)**.

14. **Hyman et al** teach a pachymeter comprising a display and at least one stored set of a plurality of predetermined locations for taking a set of pachymeter measurements wherein the display is configured to display a graphical representation of an eye marked with indicia to graphically indicate one of the predetermined locations at which a next pachymeter measurement of the set ought to be taken.

15. **Sklar et al** teach an eye device that comprise a display and at least one stored set of a plurality of predetermined locations for taking a set of pachymeter measurements wherein the display is configured to display a graphical representation of an eye marked with indicia to graphically indicate one of the predetermined locations at which a next (**new**) pachymeter measurement of the set ought to be taken (**See Figures 2 and 8 and Col.10, lines 32-52**) in order to precisely target a location in a the eye during an eye examination.

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It would have been obvious to one having ordinary skill in the art at the time invention was made to modify a pachymeter of **Hyman et al** wherein the display is configured to display a graphical representation of an eye marked with indicia to graphically indicate one of the predetermined locations at which a next **(new)** pachymeter measurement of the set ought to be taken **(See Figures 2 and 8 and Col.10, lines 32-52)** in order to precisely target a location during examination of taught **Sklar et al**. Also see supra rejection **102 (b)** under **Sklar et al**.

### ***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

17. Kremer et al (4,598,714), Lempert (US Patent 5,404,884), Sakane (Patent 4,823,801) teach related art invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LAWRENCE N. LARYEA whose telephone number is (571)272-9060. The examiner can normally be reached on 9:30 a.m.-5:30 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

LNL

/Eric F Winakur/  
Primary Examiner, Art Unit 3768

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